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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,264	09/30/2002	Masahide Tanaka	106121.03	5673
25944	7590	11/01/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			HERNANDEZ, NELSON D	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/065,264

Applicant(s)

TANAKA ET AL.

Examiner

Nelson D. Hernandez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/21/02, 1/23/2003, 4/27/04, 7/14/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** Claim 8 recites "A computer program product executable by a controller of a digital image storage for use with a digital camera..." A computer program product as claimed does not define structural and functional interrelationships between the data structure and the computer software and hardware components, which permit the data structure's to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process; therefore the invention as claimed is non-statutory. For examining purposes the claim will be read as "A digital image storage (Fig. 5: 1000) encoded with a computer program that realizes a computer for use with a digital camera..."

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 1, 2, 4-7 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis, US Patent 6,721,001 B1 in view of Niikawa, US Patent 6,947,075 B1.**

**Regarding claim 1,** Berstis discloses a digital image storage system (See fig. 1) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera is to be placed for taking out digital images stored in the memory of the digital camera; and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects a signal from the docking station and causes transmission of the digital images subsequent to receipt of the signal; Berstis inherently teaches that the digital image storage includes a storage medium that stores the taken out digital images (A storage medium is inherent in a personal computer to store data) (Col. 2, line 15 – col. 3, line 8; col. 4, lines 5-63).

Berstis discloses that detecting the connection between the camera and the personal computer is made by the digital camera but does not explicitly disclose that the digital image storage includes a controller that detects a signal from the docking station and causes the taking out of the digital images subsequent to receipt of the signal.

However, Niikawa teaches a photographic apparatus (Figs. 1-4) connectable to a computer (Fig. 5: 1000), wherein said computer comprises software installed in the hard

disk (Fig. 5: HD1) for detecting the connection of the digital camera in order to permit transmission of images and control of the digital camera upon connection of said digital camera (Col. 3, lines 17-46; col. 4, line 50 – col. 5, line 14; col. 6, line 63 – col. 7, line 60).

Therefore, taking the combined teaching of Berstis in view of Niikawa as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis by having the digital image storage detecting when the digital camera is connected to said digital image storage. The motivation to do so would have been to provide a photographing apparatus taught in Berstis which can easily and rapidly use the network sources by manipulations on the digital camera side, without adding special functions and performances to the digital camera so the digital camera can be kept compact without increasing power consumption as suggested by Niikawa (Col. 1, line 65 – col. 2, line 26).

**Regarding claim 2**, the combined teaching of Berstis in view of Niikawa as applied to claim 1 teaches that the controller causes the taking out of all the digital images in the memory subsequent to receipt of the signal (See Berstis, col. 4, lines 53-63).

**Regarding claim 4**, Berstis discloses that the docking station is designed to charge a battery of the digital camera when the digital camera is coupled with the docking station (Col. 3, lines 9-17).

**Regarding claim 5**, Berstis discloses that the signal is caused by the placing of the digital camera on the docking station (Col. 3, lines 17-46; col. 4, line 50 – col. 5, line 14; col. 6, line 63 – col. 7, line 60).

**Regarding claim 6**, Berstis discloses a digital image storage (Personal computer; col. 2, lines 15-46) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), digital images in the memory being transmitted from the memory to the digital image storage by way of a docking station (Fig. 1: 106) capable of being coupled with the digital camera, the digital camera comprising: a controller (Fig. 2: 208) that detects a signal from the docking station and that causes the transmission of the digital images from the digital camera to the digital image storage subsequent to the detection of the signal; the digital image storage comprises a memory (a memory is inherent in a personal computer to store data; i.e. hard disk) that stores the transmitted digital images (Col. 2, line 15 – col. 3, line 8; col. 4, lines 5-63).

Berstis discloses that detecting the connection between the camera and the personal computer is made by the digital camera but does not explicitly disclose that the digital image storage comprises a controller that detects a signal from the docking station and that causes the transmission of the digital images from the digital camera to the digital image storage subsequent to the detection of the signal.

However, Niikawa teaches a photographic apparatus (Figs. 1-4) connectable to a computer (Fig. 5: 1000), wherein said computer comprises software installed in the hard disk (Fig. 5: HD1) for detecting the connection of the digital camera in order to permit transmission of images and control of the digital camera upon connection of said digital

camera (Col. 3, lines 17-46; col. 4, line 50 – col. 5, line 14; col. 6, line 63 – col. 7, line 60).

Therefore, taking the combined teaching of Berstis in view of Niikawa as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis by having the digital image storage detecting when the digital camera is connected to said digital image storage. The motivation to do so would have been to provide Bersits with a photographing apparatus which can easily and rapidly use the network sources by manipulations on the digital camera side, without adding special functions and performances to the digital camera so the digital camera can be kept compact without increasing power consumption as suggested by Niikawa (Col. 1, line 65 – col. 2, line 26).

**Regarding claim 7**, the combined teaching of Berstis in view of Niikawa as applied to claim 6 teaches that the controller causes the taking-out of all the digital images in the memory of the digital camera subsequent to receipt of the signal (See Berstis, col. 4, lines 53-63).

**Regarding claim 9**, Berstis discloses a digital image storage (Fig. 1) system for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera is to be placed for taking out digital images stored in the memory of the digital camera; and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects a signal from the docking station

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and that executes a program for taking out the digital images from the memory of the digital camera, and the digital image storage comprises a storage medium (a storage medium is inherent in a personal computer to store data; i.e. hard disk) that stores the taken out digital images, the program being automatically started subsequent to detection of the signal (Col. 2, line 15 – col. 3, line 8; col. 4, lines 5-63).

Berstis discloses that detecting the connection between the camera and the personal computer is made by an controller in the digital camera but does not explicitly disclose that the digital image storage comprises a controller that detects a signal from the docking station and that causes the transmission of the digital images from the digital camera to the digital image storage subsequent to the detection of the signal.

However, Niikawa teaches a photographic apparatus (Figs. 1-4) connectable to a computer (Fig. 5: 1000), wherein said computer comprises software installed in the hard disk (Fig. 5: HD1) for detecting the connection of the digital camera in order to permit transmission of images and control of the digital camera upon connection of said digital camera (Col. 3, lines 17-46; col. 4, line 50 – col. 5, line 14; col. 6, line 63 – col. 7, line 60).

Therefore, taking the combined teaching of Berstis in view of Niikawa as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis by having the digital image storage detecting when the digital camera is connected to said digital image storage. The motivation to do so would have been to provide Berstis with a photographing apparatus which can easily and rapidly use the network sources by manipulations on the digital camera side, without



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adding special functions and performances to the digital camera so the digital camera can be kept compact without increasing power consumption as suggested by Niikawa (Col. 1, line 65 – col. 2, line 26).

**Regarding claim 10**, Berstis discloses a digital image storage system (Fig. 1) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera is to be placed for taking out digital images stored in the memory of the digital camera; and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects change of status of the docking station (detects connection between camera and docking station) and that causes the taking out of the digital images subsequent to the detection of the change in status, and the digital image storage comprises a storage medium (a storage medium is inherent in a personal computer to store data; i.e. hard disk) that stores the taken out digital images.

Berstis discloses that detecting the connection between the camera and the personal computer is made by an controller in the digital camera but does not explicitly disclose that the digital image storage comprises a controller that detects a signal from the docking station and that causes the transmission of the digital images from the digital camera to the digital image storage subsequent to the detection of the signal.

However, Niikawa teaches a photographic apparatus (Figs. 1-4) connectable to a computer (Fig. 5: 1000), wherein said computer comprises software installed in the hard

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disk (Fig. 5: HD1) for detecting the connection of the digital camera in order to permit transmission of images and control of the digital camera upon connection of said digital camera (Col. 3, lines 17-46; col. 4, line 50 – col. 5, line 14; col. 6, line 63 – col. 7, line 60).

Therefore, taking the combined teaching of Berstis in view of Niikawa as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis by having the digital image storage detecting when the digital camera is connected to said digital image storage. The motivation to do so would have been to provide Berstis with a photographing apparatus which can easily and rapidly use the network sources by manipulations on the digital camera side, without adding special functions and performances to the digital camera so the digital camera can be kept compact without increasing power consumption as suggested by Niikawa (Col. 1, line 65 – col. 2, line 26).

**Regarding claims 11-13**, Berstis discloses that the docking station has a shape to fit a bottom of the digital camera (See fig. 1; col. 2, lines 15-39).

**6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis, US Patent 6,721,001 B1 in view of Niikawa, US Patent 6,947,075 B1 and further in view of Davison, US Patent 6,516,099 B1.**

**Regarding claim 3**, the combined teaching of Berstis in view of Niikawa fails to teach that the controller causes the taking out of the digital images in order of the time when respective digital images were taken by the digital camera.

However, transferring images from a digital camera to an external device in the same order that said images were captured is notoriously well known in the art as taught by Davison wherein a camera (Fig. 1: 12) takes a plurality of images and a computer (Fig. 1: 12) downloads said images in the same order said images were taken in order to display the images in a display (Fig. 1: 18) in the same order the images were taken (Col. 7, lines 34-60).

Therefore, taking the combined teaching of Berstis in view of Niikawa and further in view of Davison as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital image storage system by taking out of the digital images in order of the time when respective digital images were taken by the digital camera. The motivation to do so would have been to help to organize a group of images taken at different points of view of an object to be composed into a single image as suggested by Davison (Col. 2, lines 1-37); also would help an user organizing the images when having a large amount of images stored in the digital camera or the digital image storage and to properly.

**7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over in Niikawa, US Patent 6,947,075 B1 <sup>in</sup> view of Berstis, US Patent 6,721,001 B1.**

**Regarding claim 8,** Niikawa discloses a digital image storage (Fig. 5: 1000) encoded with a program for use with a digital camera (Figs. 1-4) having a memory (Fig. 4, items 209 and 8), digital images in the memory being transmitted from the memory to the digital image storage by way of a communication interface (Fig. 4: 213; USB or wireless; col. 6, lines 5-25) capable of being coupled with the digital camera, the

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computer program product storing a program comprising instructions to cause the controller to perform the steps of: detecting receipt of a signal from the digital camera (using software installed in the hard drive to detect the connection of the digital camera); causing the transmission of the digital images from the digital camera to the digital image storage subsequent to the detection of the receipt of the signal; and storing the transmitted digital images in a memory (Fig. 5: HD1) of the digital image storage (Col. 3, lines 17-46; col. 4, line 50 – col. 5, line 4; col. 6, line 9 – col. 7, line 60).

Niikawa fails to teach that the digital images in the memory being transmitted from the memory to the digital image storage by way of a docking station and detecting said docking station.

However, Berstis discloses a digital image storage system (See fig. 1) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera is to be placed for taking out digital images stored in the memory of the digital camera; and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects a signal from the docking station and causes transmission of the digital images subsequent to receipt of the signal; Berstis inherently teaches that the digital image storage includes a storage medium that stores the taken out digital images (a storage medium is inherent in a personal computer to store data) (Col. 2, line 15 – col. 3, line 8; col. 4, lines 5-63).

Therefore, taking the combined teaching of Niikawa in view of Berstis as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Niikawa by having the digital images in the memory being transmitted from the memory to the digital image storage by way of a docking station and detecting said docking station in order to transmit the images to said digital image storage from said digital camera. The motivation to do so would have been to alleviate the need to use a cable to connect the camera to the host, as is done with other digital still cameras and which may require restarting the local host to recognize the newly connected camera, this would also improve the operability and reduce the time needed to connect a camera to a host.

#### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernandez whose telephone number is (571) 272-7311. The examiner can normally be reached on 8:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Yen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson D. Hernandez  
Examiner  
Art Unit 2612

NDHH  
October 27, 2005



NGOC-YEN VU  
PRIMARY EXAMINER